

Remarks:

Reconsideration of the application in view of the above amendments and following remarks is requested. Claims 9-26 are now in the case. Claims 9, 12 – 16, 18, 22 – 25 have been amended. Support for these amendments can be found at least in the claims as originally filed. Applicants assert that the present amendment adds no new matter. Applicants reserve the right to prosecute claims to cancelled subject matter in one or more continuing applications.

Claim Rejections – 35 USC § 102

Claims 9, 11, 13 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yayon (U.S. Patent No. 7,009,039).

The claims now recite an admixture that consists of FGF18 and hyaluronic acid. Such an admixture is not disclosed (or anticipated) in the '039 patent. Accordingly, this rejection is properly withdrawn and such action is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 9, 12-13, 17-18, 20-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yayon (U.S. Patent No. 7,009,039) as applied to claims 9, 11, 13 and 15-16 above and further in view of Kikuchi (Osteoarthritis Cartilage. 1996 Jun;4(2):99-110). Additionally, Claims 9-10, 13-14, 18-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yayon (U.S. Patent No. 7,009,039) as applied to claims 9, 11, 13 and 15-16 above and further in view of Kikuchi (Osteoarthritis Cartilage. 1996 Jun;4(2):99-110) as applied to claims 9, 12-13, 17-18, 20-22 and 24-26 above and further in view of MacPhee (U.S. Patent No. 6,054,122).

The claims now recite an admixture that consists of FGF18 and hyaluronic acid. Such an admixture is not disclosed nor suggested in any of the cited art. The disclosure of '039 patent, the base disclosure of this rejection, is a prime example of a teaching which can result, in the best case scenario, as an obvious to try situation. That disclosure describes hundreds of agents and a combination of any two is no more than obvious to try. It should be noted that there is not one experimental result in the '039 disclosure using in any combination of any fibroblast growth factor with hyaluronic acid, let alone both together. Furthermore, because of the huge numbers of combinations of therapeutic molecules described in this patent, there is simply no reasonable expectation of success for increasing chondrocyte proliferation or treatment of osteoarthritis with a

combination of two randomly chosen molecules out of the many disclosed. Such reasonable expectation of success must be present for the Examiner's prima facie case of obviousness to be made. Neither the disclosures of Kikuchi (high molecular hyaluronic acid alone) nor the disclosures of MacPhee (injection of a mixture of tissue sealants) do anything to remedy this deficiency.

Furthermore, the present rejection must have been formulated using improper hindsight construction. Only in hindsight could the '039 patent be said to "teach" the present invention – the Examiner would have to cherry-pick FGF18, cherry-pick hyaluronic acid, and then combine it to find obvious the present disclosed treatment method. There is simply no evidence in the prior art, experimental or otherwise, that FGF18 and hyaluronic would provide an effective treatment method for osteoarthritis or as a means for increasing chondrocyte proliferation. That occurs only through the experiments disclosed in the present specification. Because of the lack of a prima facie case of obviousness, withdrawal of this rejection is therefore requested.

On the basis of the above amendments and remarks, Applicants believe that each rejection has been addressed and overcome. Reconsideration of the application and its allowance are requested. If for any reason the Examiner feels that a telephone conference would expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (206) 442-6752.

Respectfully Submitted,



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Enclosures:

Petition and Fee for Extension of Time

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